REMARKS

The Examiner has made a new prior art rejection – namely a rejection of independent method claim 42 and independent system claim 55 under 35 U.S.C. §103 as unpatentable over Reihl in view of Frank further in view of a third reference Hansmann, and further in view of a new fourth reference DeGraw.

At the outset, Applicants note that the U.S. Supreme Court has recently clearly stated that a fact finder should be aware of the distortion caused by hindsight bias and must be cautious of arguments relied upon by *ex post* reasoning. *KSR v. Teleflex, Inc.*, 127 S.Ct. 1727, 1742 (2007). The Supreme Court warned against a temptation to read into the prior art the teachings of the invention in issue and instructing courts to guard against slipping into the use of hindsight. *KSR* at 1742. Here, the Examiner now combines four separate references from different unrelated fields. In view of the large number of references being combined and the fact that they are in unrelated fields indicates that the Examiner is being guided more by Applicants' claim elements and steps of claim 42 rather than what would be truly obvious to one skilled in the art. The lack of obviousness and the lack of a teaching, suggestion, or motivation to combine, which demonstrates that lack of obviousness, an approach approved by the Supreme Court in *KSR*, is also described below.

Claim 42 has been amended in part based on some of the observations and implied suggestions by the Examiner, and also to more clearly distinguish.

Claim 42 first distinguishes by reciting a method for controlling material flow in production of a product comprised of a plurality of individual mechanical or electronic assembly components as parts or part aggregates for assembly into said product, and recites at the end of the claim assembling said product from said electronic or mechanical assembly components. In Reihl the Examiner relies on the toner container having the transponder thereon and containing toner as representing the individual part. But even if a plurality of these toner containers is delivered to a printer there is no assembly of a printer occurring but only replacement of spent toner containers with new toner containers with new toner in a printer. Thus there is no production of a product in Reihl. Also in the three secondary references there is no production of a product with a plurality of individual mechanical or electronic assembly components. Frank is only a tray containing dentures, eyeglasses, and hearing aids. But there is no assembly into a product. Hansmann is a checkout service not relating at all to assembly of electronic or mechanical assembly components into a product. The same is true of DeGraw which simply inspects semiconductor components and if the semiconductor component does not meet an inspection standard, then that component is not delivered. But there are no plurality of components being assembled into a product.

Next, claim 42 distinguishes by reciting recording production and delivery data and in addition recording quality data comprising at least one tolerance value range regarding the individual mechanical or electronic assembly components. For this feature the Examiner uses storage in the transponder on the toner container of a description of the toner and an

expiration date of the toner. But the toner is not a mechanical or electronic assembly component, and also is not being assembled into a product. Toner is merely a consumable item (a chemical compound) being consumed by the printer but is not one of a plurality of components used to assemble a printer. Although the toner expiration date may be a tolerance value for the toner, this expiration date is not a tolerance value for a mechanical or electronic assembly component to assemble a printer. The printer has already been previously assembled at the factory and there is no assembly of the printer occurring in Reihl, but merely a replenishment with new toner.

The secondary references do not satisfy this deficiency. Frank has nothing to do with assembly but only is a tray with dentures and eyeglasses and hearing aids. Hansmann is only a checkout system for goods. DeGraw is only an inspection station for inspecting semiconductor leads and rejecting the components if they do not pass inspection criteria. And there is no teaching, suggestion, or motivation to combine with Reihl since they have nothing to do with an assembly site for manufacturing of a product.

Claim 42 next distinguishes by reciting storing the production and delivery data and the quality data in an individual transponder physically connected to each individual part or individual part aggregate. Although the transponder is connected to the toner bottle containing toner in Reihl, this is not a transponder physically connected to an individual part or individual part aggregate which is a mechanical or electronic assembly component for creating a product.

Claim 42 next distinguishes by reciting reading the production and delivery data from the transponder at a goods receipt and using the data for

controlling further material flow such that the individual parts or part aggregates are transported in a controlled manner to predetermined, subsequent assembly process stations at an assembly production site for said product. In Reihl there is no such data in the toner transponder for directing a component to an assembly porous station for assembly of the printer. There is only supply of one or more toner containers to replace used toner containers in the printer. The toner type and the expiration date stored in the transponder of the toner container is nowhere disclosed in Reihl as being used for transporting to assembly process stations at an assembly production site for the product. The printer is not being assembled with the toner containers. The three secondary references also do not satisfy this deficiency as described above. The Frank reference has no teaching, suggestion, or motivation for use in an assembly production site for a product being assembled from components. There is also no teaching, suggestion, or motivation to use DeGraw because DeGraw is only inspecting parts and is not assembling those parts at an assembly production site. There is thus also no teaching, suggestion, or motivation for DeGraw. The same is true, of course of Hansmann which is only a checkout system and there is no teaching, suggestion, or motivation to combine Hansmann with a reference for an assembly production site.

Claim 42 next distinguishes by reciting before storage reading and checking the at least one tolerance value range at a quality check station of the assembly production site and if the quality check yields that the mechanical or electronic assembly components as said delivered parts or part aggregates lie outside of the at least one tolerance value range, rejection and

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return is automatically activated. The Examiner agrees that the primary reference Reihl does not have this feature. Therefore the Examiner cites the fourth new reference DeGraw. But DeGraw only teaches an inspection station for rejection semiconductor components but there is no teaching in DeGraw about assembling the components into a product, the key feature missing in Reihl. There is also no teaching, suggestion, or motivation to combine DeGraw with Reihl since neither of them relates to an assembly production site assembling mechanical or electronic components into a product.

Claim 42 next distinguishes by reciting taking an individual parts by an assembly production site operator and storing them in an assembly production site storage. But Reihl has no assembly production site storage for assembling a product, and neither do any of the other three references.

Claim 42 finally distinguishes by reciting detecting with the transponder reader a removal of an individual part or part aggregate from the assembly production site storage for its assembly to produce the product and only triggering a payment obligation for the assembly production site operator upon the transponder reader detecting removal of the individual part or part aggregates from the assembly production site storage, and assembling the product from the electronic or mechanical assembly components. For this feature the Examiner cites Hansmann which is a checkout system reading a transponder for invoicing when an item is bought for a product. But since Hansmann is not an assembly production site, there is no teaching, suggestion, or motivation to combine with Reihl which itself is not an

assembly production site. Hansmann's reading of his transponder for invoicing has nothing to do with parts being assembled into a product.

Dependent claims 43-49 and 51-54, and new dependent claim 60 distinguish at least for the reasons noted with respect to claim 42 and also by reciting additional features.

Applicants particularly note dependent claim 43 reciting that at least one group of the individual parts or part aggregates is a mass production article that is delivered at the goods receipt in a quantity of more than five in a container, and wherein the container has the transponder connected thereto in which is stored a common quality score regarding the group of mass production articles in the container. For this the Examiner cites Reihl Figure 2 reference no. 7. However, 7 is just a warehouse containing a plurality of containers (Reihl, column 7, lines 10-15). In the system of Reihl each container 2 carries a transponder. Lines 65-67 clearly state that each container 2 can be identified by its transponder. This is contrary to the language of claim 43 that the individual parts are delivered in a container as a group of more than five parts and that the container has a transponder in which is stored a common quality score regarding the group of mass production articles of the container.

Attention is also drawn to dependent claim 51 reciting that the data belonging to an individual part or individual part aggregate and stored on its connected transponder, are stored on a further finished product transponder located said assembled product in a finished state. For this the Examiner cites Reihl column 7, lines 20-23. However, this portion of Reihl only is dealing with distinguishing between toner supply containers and waste

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disposal containers. This has nothing to do with the subject matter of claim 51.

Particular attention is also drawn to new dependent claim 60 reciting deviating data being additionally stored on the respective individual transponder. This feature is nowhere suggested in any of the four references.

System claim 55 is allowable at least for the reasons noted with respect to claim 42. Similarly, new dependent claims 57-59 are allowable for the reasons noted above with respect to claim 43, 51, and new claim 60.

Allowance of the application is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required or to credit any overpayment to account no. 501519.

Respectfully submitted,

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